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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------------|---------------------|------------------|
| 10/591,662 | 09/05/2006 | Karl Ott | 295335US0PCT | 3137 |
| 22850 7590 08/22/2011 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | | |
| EXAMINER GRESO, AARON J | | | | |
| ART UNIT 1726 | | PAPER NUMBER | | |
| NOTIFICATION DATE 08/22/2011 | | DELIVERY MODE ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/591,662

Applicant(s)

OTT ET AL.

Examiner

AARON GRESO

Art Unit

1726

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 August 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
EXAMINER NOTE: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: None.
Claim(s) objected to: None.
Claim(s) rejected: 15-25.
Claim(s) withdrawn from consideration: None.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/JAMES J. SEIDLECK/
Supervisory Patent Examiner, Art Unit 1765

/Aaron J. Greso/

Continuation of 11. does NOT place the application in condition for allowance because: Continuation of 11. does NOT place the application in condition for allowance because:

In regard to the Affidavit of 12 August 2011:

Affidavit is identical to the one placed into the record of 11 July 2008

Applicant Affidavit filed does not further compare the unexpected results for compositions of the closest prior art. Although the Affidavit is applicable to the instant Specification, to which the instant Claims are not limited; in the present case, the Affidavit does not further include an evaluation for test results identified as a composition in the prior art of record. The prior art of record comprises a colorant; as such, the affidavit is taken as not providing for unexpected results in regard to the prior art of record.

Evidence of superiority must pertain to the full extent of the subject matter being claimed {In re Ackermann, 170 USPQ 340; In re Chupp, 2 USPQ2d 1437; In re Murch 175 USPQ 89; Ex Parte A, 17 USPQ 2d 1719}.

Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims.

Per Applicant Arguments:

(1) That two lists of materials indicated in Pears et al. (WO 99/50362 page 4 lines 29-32 or page 7 lines 16-17 and 31-32) involving N-methyl pyrrolidone with N-ethyl pyrrolidone and N-methyl pyrrolidone, are not interchangeable {pages 6-7}.

In response, the reference discloses that both applicable lists apply towards water soluble solvents applicable to materials employed. As materials in one list apply to applications in the other list, the materials in both lists are taken as the same or similar material applied for the same or similar applications.

2) That Homologous arguments are invalid as unexpected results are applicable {page 7}.

In response: Applicability of the affidavit are addressed above.

Further, when steam is taken as a hydro material:

When placing more hydrophobic moieties in a composition, it would be expected by one of ordinary skill in the art that when including more hydrophobic moieties, such as an additional CH₂ or cyclohexy group, in a composition, would avail the composition to be more hydrophobic. As steam is taken as hydro material, a more hydrophobic material would be expected to be more phobic to steam.

3) Applicants further argue: Argabright is not related or applicable to rejections over Pears {page 7 of 8 penultimate paragraph}: In response, Argabright is employed to show similarities of properties between ethyl and methyl pyrrolidone, as would be expected to be employed in the art as materials for isocyanate-based compositions.

4) That Bruchmann does not cure alleged deficiencies of Pears as evidenced by Argabright {page 8 of 8}:

In response: As Pears is not found deficient, Bruchman is not required to address alleged deficiencies.

The rejections are held.